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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,286	10/22/2003	Thomas C. Chuang	0031000	4915

7590 07/13/2005

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,286

Applicant(s)

CHUANG, THOMAS C.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 23-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's response of 4/25/05 has been entered. Currently claims 23-30 are pending.

1. The amendment filed 4/25/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: See the 112,1st rejection of the claims where this is explained in detail by the examiner.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 23-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claim 23,29, the specification as originally filed did not disclose the claimed limitations of status identifiers of "available" and "unavailable" as claimed. The specification discloses that the rental queue is divided into three separate lists that are "Checked out", "DVD's in Queue", and "Awaiting Release". The examiner cannot find any disclosure of "available" and "unavailable" as claimed. The examiner feels that

absent any showing of support for the newly added language from the specification as originally filed that these limitations must be considered as new matter. Also considered to be new matter is the recitation that the optimized purchase price is generated by searching all of the user's data queue structures to identify the frequency of appearance of the disk identifier. Where was this disclosed in the specification as originally filed? The generation of a purchase price for a disk that is in a checked out status is disclosed with respect to figure 5B in the specification (paragraphs 50-55). The examiner does not see where it has been disclosed that the optimized purchase price is generated by searching all of the user's data queue structures to identify the frequency of appearance of the disk identifier. It is disclosed that in one embodiment the purchase price is the wholesale price paid by the web site plus the desired profit. Another embodiment is using a baseline price determined by current market demand. Neither of these two embodiments support what is claimed. Paragraph 51 discusses the determination of how many copies the web site owns for the disk the price is being generated for. It is stated that the historical and current rental patterns are looked at but this does not seem to provide support for "searching all of the user's data queue structures to identify the frequency of appearance of the disk identifier". The examiner does not see where this limitation was disclosed in the specification as originally filed.

For claim 24, the specification as originally filed did not disclose that additional packaging is provided to the purchaser. Additional disks are disclosed as being offered but not packaging. A product like a disk and packaging that is used to package an

article are two entirely different things. Where is support for what is claimed found in the specification as originally filed?

For claims 25,30, applicant is claiming the requesting of a purchase price for a disk with an available status. To start with, the examiner is not clear as to what is meant by "available status" so as best understood by the examiner, this claim is directed to the purchasing of a disk that is in inventory. Also, because a disk that has a status of "Awaiting release" from the specification is not available yet, this leads the examiner to conclude that "available status" has to be for a disk in inventory at the present time. Applicant goes on to claim that an optimized price and a future price are determined for the disk with the available status. This is where the examiner has a problem. The determination of a future price is only disclosed with respect to disks that are not released yet (not available). This is discussed with respect to figure 5A, paragraphs 46-49. It is not disclosed that there is any future price generated for a disk that is available. If the disk is available the price determination seems to be that as disclosed in paragraphs 33,34. It is not disclosed that any future price is determined for a disk that is available, only when the disk is not release yet (figure 5A). The examiner concludes claim 25 to contain new matter because the specification as originally filed does not provide support for what is claimed.

For claim 26, the specification as originally filed does not provide support for what is claimed. It is not disclosed that for a disk that is available (not the awaiting release embodiment) an optimized and future price are determined, and it is not disclosed that the user queue structure is searched as claimed. The specification

discloses that for a disk awaiting release demand forecasting is performed where box office receipts for the DVD title and rental patterns of prior DVD titles with similar box office receipts are used. Even if applicant were claiming the price determination for a disk awaiting release, with respect to an optimized and future price, no searching of the user queue data structures is disclosed as claimed. The examiner concludes the claim to be reciting new matter.

For claim 27, the specification as originally filed did not disclose that the frequency of appearance is determined by tallying the frequency of checked out status and available status as claimed. The closest the specification comes to support for this limitation is where it discloses that that the historical and current rental patterns are looked at but this portion of the specification did not state what is claimed. Where is this supported in the specification as originally filed? Searching a rental pattern both historical and current does not seem to provide support for the searching of checked out disks and available disks.

4. Claims 23-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For claim 23, it is not clear how the optimized purchase price is being generated. It is claimed that the frequency of the occurrence of the disk is searched and then the optimized price is displayed to the user. How is the optimized price determined after the

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frequency of occurrence has been determined? This is not disclosed and one of skill in the art would be left to guess as to how to determine the price. Undue experimentation would necessarily be involved because one would not have any idea how the price is determined from the resulting frequency number. If it is determined that the frequency for a given disk is 150 times, as opposed to another disk that is 50 times, how is this used to generate the optimized purchase prices? It is not clear how the resulting number of frequency occurrence is used to generate a price. The examiner concludes this claim to be non-enabled as undue experimentation would be involved to figure out how to practice the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 23,25²⁹, because the specification makes no mention at all of the status of "available" and "unavailable", it is not known what this means. The specification discloses that the rental queue is divided into three separate lists that are "Checked out", "DVD's in Queue", and "Awaiting Release". The examiner cannot find any disclosure of "available" and "unavailable" as claimed. What is the scope of these terms? Is the unavailable supposed to be the same as "Awaiting Release" or does this mean that the desired disk is in stock but the user already has reached the queue limit and cannot receive any more disks? It is not clear at all as to what these terms mean,

DR
7/11/05

mostly because it appears to be new matter not disclosed in the specification and/or applicant is using new terminology to define the invention and is not being consistent with the language of the specification. The examiner is just left guessing what these terms mean.

For claim 25, what optimized price is being displayed? Is this the optimized price of claim 23 or the one recited in claim 25? Two are recited and the examiner is not clear as to which one is being displayed.

7. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DENNIS RUHL
PRIMARY EXAMINER